

REMARKS

This Response is submitted in reply to the Office Action dated January 27, 2010, having a shortened statutory period set to expire April 27, 2010. No amendments to the claims have been made. Reconsideration of the present case is earnestly requested in light of the following remarks.

Claim Rejections -- 35 USC §101

Claims 27-52 and 55 are rejected under 35 USC §101 as being directed to non-statutory subject matter. That rejection is respectfully traversed and reconsideration of the claims is requested.

Claim Rejections -- 35 USC §103

Claims 27-52 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Horan* (US 6220596) in view of *Weingardt* (US 5727786) and further in view of *Weeks* (US 3549150). Those rejections are respectfully traversed and reconsideration of the claims is requested.

1. Claim 27

Independent Claim 27 recites a method of playing a game of bingo. The method involves, *inter alia*:

(c) associating each of [a] plurality of subsets [of potential numbers] with at least one bingo card column;
[. . .]

(e) designating at least one first pattern of spaces on a bingo card as determinative of a winner of the game, wherein the pattern includes at least a column of spaces on the bingo card;

(f) providing at least a first set of colors;

(g) associating each of the first set of colors with a win enhancement value;

(h) prior to performing step (c), associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column; [and]

(j) paying [. . .] a win value if [. . .] a bingo card [has] numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern;

(k) paying, in addition to the win value, a first bonus [. . .] wherein the

value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs.

The Examiner takes the position that the *Horan-Weingardt-Weeks* combination teaches or renders obvious all the features of Claim 27 listed above. First, the Examiner admits on pages 4 and 5 of the present Office Action that neither *Horan* nor *Weingardt* discloses “the feature of associating the first set of colors to column without regard to the associated subset of potential numbers for the column.” The Examiner then goes on to argue that *Weeks* teaches this elements in Figure 1 and col. 1, lines 47-61 and to posit that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Horan* in view of *Weingardt* “by incorporating *Weeks* teaching of assigning each column with distinctive color differing from the colors employed in the remaining columns in order to provide a comprehensive combination of color, spaces, patterns and numbers adding to the bingo game that will allow more payouts to be made by the gaming establishment that results in increased and encouraged player participation.” (see p. 5 of the present Office Action). However, the Examiner fails to present any evidence that the *Horan-Weingardt-Weeks* combination teaches or renders obvious the element “(k) *paying, in addition to the win value, a first bonus [. . .] wherein the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs,*” as recited in Claim 27. The Examiner appears to be arguing that *Horan* discloses this element when the Examiner posits “*Weingardt* teaches providing a first set of colors (col. 4, lines 61-65), associating each of the first set of colors with the win enhancement value (col. 5, lines 43-45), the value of the first bonus equals the win enhancement value associated with the color associated with column in which the win occurs (col. 7, lines 4-27),” on pages 4-5 of the present Office Action. It is *Horan’s* teaching therein that a bonus is paid out based on the color of the BINGO numbers. Paying out a bonus based on the color of randomly placed numbers within a bingo card is unrelated to a methodology of paying out a bonus based on the “color associated with the column in which the win occurs” as is recited in the Claim 27 in the present application.

The Examiner cites *Weeks* as disclosing associating colors with the columns but *Weeks*, similar to *Horan*, teaches that the bonus is paid out based on the accomplishment of BINGO, which relates to element (j) of Claim 27, but in no way renders obvious elements (k) of Claim 27. What none of the references, taken individually or in combination suggest is paying out an additional bonus “wherein the value of the first bonus equals the win enhancement value

associated with the color associated with the column in which the win occurs” (emphasis added), as recited in independent Claim 27. *Weeks* teaches generating a win based on completing a full row across of a color-number combination. Similarly, *Weingardt* teaches that an enhanced bonus is earned if all of the bingo numbers are of the same color. As can be seen, neither of these references disclose or render obvious paying out an additional bonus based on a column color in which the bingo occurs.

In support of the Examiner’s position that element (k) of Claim 27 is rendered obvious by the Horan-Weingardt-Weeks combination, the Examiner refers to col. 7, lines 4-27 of Horan. However, as has been explained, nothing within the detailed description of preferred embodiments in Weingardt even mentions the word “column.” Thus, in effect, the Examiner argues that since the game of bingo involves patterns and numbers (as taught by Horan), and since Weingardt associates colors with groups of numbers, and further since Weeks teaches associating a color with a column, then any combination, grouping, or association of colors, patterns, and numbers would be obvious. Applicant respectfully disagrees.

Applicant submits that it is improper for the Examiner to select only those portions of a prior art reference that seem to address Applicant’s claimed subject matter without taking into consideration the entirety of the teaching of the prior art reference. More specifically, according to *In re Ratti*, a prima facie case of obviousness cannot be established if a “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the prior art] as well as a change in the basic principle under which the [prior art] construction was designed to operate.” 270 F.2d at 813 (CCPA 1959); *See also* Manual of Patent Examination Procedure (MPEP) 2143.01 V (“the proposed modification cannot render the prior art unsatisfactory for its intended purpose.”); MPEP 2143.01 VI (“the proposed modification cannot change the principle of operation of a reference.”). Moreover, a reference that teaches away from the claimed subject matter cannot support a prima facie case of obviousness.

Applicant submits that Weingardt teaches away from Applicant’s claimed subject matter as recited in Claim 27. Claim 27 recites, among other things, “(k) *paying, in addition to the win value, a first bonus [. . .] wherein the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs.*” In contrast, Weingardt merely discloses associating colors with randomly selected numbers. See, for

example, Weingardt at Column 5, lines 26-33. Hence, the thrust of Weingardt, focusing on the association of a color with a group of numbers, is precisely opposite to Applicant's claimed subject matter of associating a color with a column. Thus, at least in this regard, Weingardt leads away from the subject matter of Applicant's Claim 27.

Moreover, in Weingardt, the individual numbers of a subset of numbers associated with a given column will not be associated with the same color, except under a statistically possible coincidence that numbers chosen at random for association with a given color also happen to be associated with the same bingo card column. Thus, the modification of Weingardt to arrive at Applicant's Claim 27 would require an impermissible "change in the basic principle under which [Weingardt] was designed to operate." *In re Ratti*. For at least this additional reason, Applicant submits that Weingardt teaches away from the subject matter of Claim 27.

Applicant respectfully points out that the Examiner has yet to provide a logical line of reasoning as to what in the knowledge of one of ordinary skill in the prior art would lead that person to logically modify the Horan-Weingardt-Weeks combination to arrive at the subject matter of Claim 27. The Examiner's offered rationale for modifying the prior art amounts to generalized and conclusory assertions that there would be motivation to combine Horan with Weingardt and Weeks because providing additional features to a standard bingo game would be desirable for both players and bingo game operators. (See the present Office Action at pages 3-5, for example). Applicant submits that such thin rationale falls far short of the standard required by *In re Kahn*: "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". (emphasis added).

Claims 32, 33, and 37-49 depend directly or indirectly from Claim 27. Consequently, Applicant submits that at least for the reasons offered above Claims 32, 33, and 37-49 are also not rendered obvious by Horan and Weingardt and Weeks, singly or in combination.

Therefore, Applicant submits that neither Horan nor Weingardt nor Weeks, singly or in combination, can support an obviousness rejection of Claims 27, 32, 33, and 37-49, and consequently, Applicant requests that the Examiner's rejection of Claims 27, 32, and 37-49 be reversed.

2. **Claim 28**

At page 6 of the present Office Action, the Examiner rejected Claim 28 as obvious over Horan in view of Weingardt in view of Weeks. For the following reasons, Applicant submits that Claims 28 is allowable over the references of record.

Dependent Claim 28, depending from Claim 27, calls for “*selecting at least one number at random from each of the subsets to serve as a win enhancement activator; and paying [. . .] the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator.*” The Examiner takes the position that Weingardt teaches this feature of Claim 28. The Examiner relies on Weingardt at Column 4, line 50 through Column 6, line 3. The Examiner then concludes that “[i]t would have been obvious to [. . .] to modify Horan’s invention in view of Weingardt in order to provide an additional features [sic] added to the bingo game that will allow more payouts to be made by the gaming establishment that result in increased player participation and additional revenues.”

At Column 4, line 50 through Column 6, line 3, Weingardt merely describes that colors are associated with numbers, and that different colors have different payout values. Applicant submits that nowhere does Weingardt teach or render obvious “*selecting at least one number at random from each of the subsets to serve as a win enhancement activator[.] and paying [a] bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator,*” as recited by Claim 28 (emphasis added). Applicant submits that choosing a number at random, from each of a plurality of subsets of numbers, to serve as a win enhancement activator is not the same, nor is it rendered obvious by, assigning a color to a group of randomly selected numbers, which color can serve as a win enhancer.

The Examiner’s proffered rationale as to why a person of ordinary skill in the art would be led to modify Horan-Weingardt-Weeks to arrive at the subject matter of Claim 28 is merely a generalized statement of a benefit to be derived if the modification were made. As far as Applicant can discern, the Examiner appears merely to assert that Weingardt’s association of colors and groups of randomly selected numbers makes obvious all other variations of bingo involving colors or numbers. Applicant submits that such broad and generalized basis of rejection cannot be sustained.

Therefore, Applicant submits that Claim 28 is allowable over the references of record, and respectfully requests that the Examiner’s rejection of Claim 28 be reversed.

3. **Claim 29**

At page 6 of the present Office Action, the Examiner rejected Claim 29 as obvious over the Horan-Weingardt-Weeks combination. For the following reasons, Applicant respectfully disagrees with the rejection and asks that the Examiner's rejection be reversed.

Dependent Claim 29, depending from Claim 27, additionally involves:

designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game, wherein the second pattern includes at least a row of spaces on the bingo card;
providing a set of graphics;
associating each of the set of graphics with a win enhancement value;
associating at least one of the set of graphics to rows on the bingo card;
and
paying a second bonus [if] a bingo card [has] numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one second pattern designated as a winning pattern, wherein the second bonus equals the win enhancement value associated with the graphic associated with the row in which the win occurs.

The Examiner takes the position that Horan-Weingardt teaches all the features recited in Claim 29. Specifically, the Examiner asserts that Horan teaches "associating at least one of the set of graphics to rows on the bingo card," as recited by Claim 29. As evidence for his position, the Examiner points to Weingardt at Column 1, lines 31-40, and Column 7, lines 15-24. As already discussed above, the first excerpt of Weingardt merely describes some of the well known patterns that can be used as game winning patterns in bingo. Weingardt states, for example, that in "the conventional manner of play of bingo, in order to win the game, a player must cover five spaces in a vertical column, a horizontal row or along one of the two diagonals of the bingo card. [. . .] Other winning combinations include the four corners of the bingo card and the eight numbers immediately adjacent and surrounding the free space. Winning combinations can also include the covering of spots on the bingo card so that letter symbols are formed such as an X, U, L, H or T." Weingardt at Column 1, lines 31-40. At Column 7, lines 15-24, Weingardt simply states that additional colors can be used beyond the four used in the exemplary embodiments of Weingardt. Nowhere does Weingardt render obvious "associating at least one of the set of graphics to rows on the bingo card."

Again, as already discussed above, the Examiner appears to take the position that any variations of bingo in which colors, numbers, patterns, etc., are involved would be obvious over

Weingardt's general references to winning patterns (including columns and rows) and association of colors with randomly selected numbers. Applicant submits that the Examiner, relying on Weingardt, has failed to make a prima facie case for obviousness of Claim 29. Consequently, Applicant respectfully requests that the Examiner's rejection of Claim 29 be reversed. Claims 30, 34-36, and 50-52 depend directly or indirectly from Claim 29; hence, Applicant submits that Claims 30, 34-36, and 50-52 are also allowable over the references of record.

4. Claim 31

Claim 31, depending from Claim 29, calls for "*selecting at least one number at random from each of the subsets to serve as a win enhancement activator; paying [. . .] the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator; and paying [. . .] the second bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator.*" The Examiner adopts the position that Horan-Weingardt teaches all of the features recited in Claim 31. More specifically, the Examiner alleges that Weingardt teaches or renders obvious "selecting at least one number at random from each of the subsets to serve as a win enhancement activator," then paying first and second bonuses only if a winning pattern includes the enhancement activator. In support of his position, the Examiner offers Weingardt at Column 6 (lines 42-62), Column 7 (lines 44-65), and Column 8 (lines 9-20).

However, the first cited excerpt of Weingardt only describes the association of colors with groups of randomly selected numbers (e.g., "the conventional random number generator randomly selects from the seventy-five number set two groups of bingo numbers to be designated as the first specially designated numbers and the second specially designated numbers. [. . .] a total of between nine and fifteen of the bingo numbers [. . .] are predetermined to be the 'green' numbers." *Weingardt* at Col. 6, lines 42-49.). The other two excerpts of Weingardt generally describe the use of "progressive jackpots." In the context of progressive jackpots as described by Weingardt, once a first jackpot is won, certain players might be eligible to seek a subsequent jackpot in the same game. However, that notion is different from the subject matter of Claim 31, in which a first bonus is awarded if a column contains a win enhancer and a second bonus is awarded if a row contains a win enhancer. To

further elucidate, the awarding of the second bonus in Claim 31 is not dependent on the awarding of the first bonus, which is to be contrasted to the notion of progressive jackpots discussed in Weingardt.

Thus, Applicant submits that Weingardt does not support the Examiner's prima facie case of obviousness of Claim 31. Applicant respectfully requests that the Examiner's final rejection of Claim 31 be reversed.

5. Claim 55

At page 9 of the present Office Action, the Examiner rejected Claim 55 as obvious over Horan-Weingardt-Weeks. For the following reasons, Applicant submits that Claim 55 is allowable over Horan and Weingardt and Weeks, singly or in combination.

Independent Claim 55 is directed to a method of playing a bingo game. The method involves, in relevant part:

(c) associating each of [a] plurality of subsets [of potential numbers] with at least one bingo card column;

(e) designating at least one first pattern of spaces on a bingo card as determinative of a winner of the game, wherein the pattern includes at least a column of spaces on the bingo card;

(f) providing at least a first set of colors;

(g) associating each of the first set of colors with a win enhancement value;

(h) prior to performing step (c), associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column;

(i) designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game, wherein the second pattern includes at least a row of spaces on the bingo card;

(j) providing a set of graphics;

(k) associating each of the set of graphics with a win enhancement value;

(l) associating at least one of the set of graphics to rows on the bingo card;

(m) selecting at least one number at random from each of the subsets to serve as a win enhancement activator;

(o) paying [...] a win value if [...] a bingo card [has] numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern;

(p) paying, in addition to the win value, a first bonus [if] a bingo card [has] numbers matching those selected from the set of potential numbers, if the pattern formed by the matching numbers matches the at least one first pattern

designated as a winning pattern, and if the pattern formed by the matching numbers contains at least one win enhancement activator, wherein the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs; and

(q) paying, in addition to the win value, a second bonus [if] a bingo card [has] numbers matching those selected from the set of potential numbers, if the pattern formed by the matching numbers matches the at least one second pattern designated as a winning pattern, and if the pattern formed by the matching numbers contains at least one win enhancement activator, wherein the value of the second bonus equals the win enhancement value associated with the graphic associated with the row in which the win occurs.

As can be seen, independent Claim 55 brings together many of the features recited in various other independent and dependent claims previously argued as being patentable over the Horan-Weingardt-Weeks combination. Hence, the Examiner took the position that all the features of Claim 55 were obvious over the Horan-Weingardt-Weeks combination, and reinstated the same reasons for rejection as used with other claims.

Applicant submits, however, that it is impermissible for the Examiner to atomize Applicant's claim, purport to identify in the prior art each atom of a whole claim, and then combine the atoms together with little rationale of a logical nexus between the atoms. In other words, the Examiner must consider Claim 55 as a whole. As stated in the MPEP, "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." 2106.II.C. (*citing, Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981).

Somewhat simplifying, Claim 55 recites association of colors with columns without regard to the numbers associated with a given column, association of graphics with rows, selection of win enhancers, and different payouts in the same game depending on whether a winning pattern is associated with a given color, graphic, and/or win enhancer. While Horan describes winning patterns of numbers, and Weingardt teaches association of colors with randomly selected numbers, nowhere does the Horan-Weingardt-Weeks combination teach or render obvious a bingo game as recited by Claim 55. As previously argued, not only does the Horan-Weingardt combination fail to teach or render obvious numerous features of Claim 55, but additionally, Weingardt teaches away from various aspects of Claim 55. Therefore, Applicant submits that the Horan-Weingardt-Weeks combination does not support a prima facie case of obviousness, and that Claim 55 is allowable over Horan and Weingardt and Weeks, singly or in

combination. Applicant respectfully requests that the Examiner's final rejection of Claim 55 be reversed.

Having now responded to each rejection set forth in the present Office Action, Applicant believes all pending claims are now in condition for allowance and respectfully request such allowance. Applicant invites the Examiner to contact the undersigned at the below listed telephone number if a telephone conference would expedite prosecution of this application.

Respectfully submitted,

/Craig J. Yudell/

Craig J. Yudell
Reg. No.39,083
DILLON & YUDELL LLP
8911 N. Capital of Texas Highway
Suite 2110
Austin, Texas 78759
512.343.6116

ATTORNEY FOR APPLICANTS